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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 929,122	08/15/2001	Howard A. Epstein	3768-094-27	1334

7590 03/11/2003

Supervisor, Patent Prosecution Services
PIPER MARBURY RUDNICK & WOLFE LLP
1200 Nineteenth Street, N.W.
Washington, DC 20036-2412

EXAMINER

DAVIS, RUTH A

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/929,122

Applicant(s)

EPSTEIN ET AL.

Examiner

Ruth A. Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 04 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 4-15 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-3, 16-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Applicant's amendment filed December 4, 2002 has been received and entered into the case. Claims 1 – 20 are pending; claims 4 – 15 and 20 are withdrawn as being drawn to nonelected subject matter; claims 1 – 3 and 16 – 19 have been considered on the merits. All arguments have been fully considered.

Claim Rejections - 35 USC § 112

1. Rejections under 35 U.S.C. 112, second paragraph, have been withdrawn due to amendment.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 – 3 and 16 – 19 stand rejected under 35 U.S.C. 102(e) as being anticipated by Pelletier.

Applicant claims a composition comprising about 0.25 – 20% non-glycolic burnet extract derived compounds, 0.5 – 10% burnet derived compounds, or about 3% burnet derived compounds. Applicant additionally claims an external skin composition comprising the burnet

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extract wherein the composition is selected from a skin treatment lotion, facial freshener, moisturizing lotion, acne treatment, after shave, sunscreen, cleansing cream, skin cream, antiperspirant/deodorant and make up base. Specifically the composition is a moisturizing lotion comprising at least one each of an oil, skin conditioning agent, humectant, emulsifier and emulsion stabilizer.

Pelletier teaches cosmetic and dermatological compositions comprising at least one extract of *Sanguisorba* (burnet) in an amount of about 0.005 – 10% (abstract). Specific examples of such burnet extracts include phenolic compounds, glycosides, tannins and catechols (col.3 line 6-15). The extracts are disclosed to be effective for skin treatment lotions, antiseptics, anti-aging lotions, acne creams, skin clarifying compositions and lotions (col.3 line 16-43). The composition further contains known adjuvants to include oils, emulsifiers, co-emulsifiers (or emulsion stabilizers), keratolytic agents (skin conditioning agents), and glycerols (humectants).

The reference anticipates the claimed subject matter.

Applicant argues that Pelletier teaches burnet extracted with propylene glycol, not a non-glycolic extract and that Pelletier does not teach the claimed function thereby teaching away from the claimed invention.

However, these arguments fail to persuade because Pelletier specifically teaches the burnet may be extracted with aqueous solvents to include water and ethanol (col.3 line 65 – col.4 line 8). It is noted that applicant also uses water and ethanol (examples in specification).

Regarding the claimed function, the intended use or function of the claimed composition does not patentably distinguish the composition, per se, since such undisclosed use is inherent in

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the reference composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the composition of the prior art. In the instant case, the intended use fails to create a structural difference, thus, the intended use is not limiting.

Therefore, the claims stand rejected.

3. Claims 1 – 3 and 16 – 19 stand rejected under 35 U.S.C. 102(e) as being anticipated by Suzuki '595.

Applicant claims a composition comprising about 0.25 – 20% non-glycolic burnet extract derived compounds, 0.5 – 10% burnet derived compounds, or about 3% burnet derived compounds. Applicant additionally claims an external skin composition comprising the burnet extract wherein the composition is selected from a skin treatment lotion, facial freshener, moisturizing lotion, acne treatment, after shave, sunscreen, cleansing cream, skin cream, antiperspirant/deodorant and make up base. Specifically the composition is a moisturizing lotion comprising at least one each of an oil, skin conditioning agent, humectant, emulsifier and emulsion stabilizer.

Suzuki teaches lotions, gels, emulsions, solutions, and ointments comprising 0.0001 – 50% burnet extract (claims), vaseline/squaline (oils), stearic acid (skin conditioning agent), glycerin (humectant), monostearate (emulsifier) and lycerin monostearate (emulsion stabilizer) (example 1).

The reference anticipates the claimed subject matter.

Applicant argues that Suzuki does not teach non-glycolic extracts of burnet.

However, this argument fails to persuade because Suzuki specifically teaches the burnet can be extracted with water and ethanol, and prefers an ethanol/water mix (col.13 line 1-5), which is non-glycolic. It is noted that applicant also uses water and ethanol (examples in specification).

Therefore, the claims stand rejected.

4. Claims 1 – 3 and 16 – 19 stand rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki '052.

Applicant claims a burnet extract comprising about 0.25 – 20% burnet derived compounds, 0.5 – 10% burnet derived compounds or about 3% burnet derived compounds. Applicant additionally claims an external skin composition comprising the burnet extract wherein the composition is selected from a skin treatment lotion, facial freshener, moisturizing lotion, acne treatment, after shave, sunscreen, cleansing cream, skin cream, antiperspirant/deodorant and make up base. Specifically the composition is a moisturizing lotion comprising at least one each of an oil, skin conditioning agent, humectant, emulsifier and emulsion stabilizer.

Suzuki teaches external skin compositions comprising 0.0001 – 50% (col.14 line 27-31) burnet extract (col.13 line 25-45). The compositions further include oils, surfactants (emulsion stabilizers), emulsifiers, humectants and keratinizing ingredients (skin conditioning agents) and can be in lotion, emulsion, cream and gel forms (col.14 line 39-61).

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The reference anticipates the claimed subject matter.

Applicant argues that Suzuki does not teach non-glycolic extracts of burnet.

However, this argument fails to persuade because Suzuki specifically teaches the burnet can be extracted with water and ethanol, and prefers an ethanol/water mix (col.13 line 64 – col.14 line 4), which is non-glycolic. It is noted that applicant also uses water and ethanol (examples in specification).

Therefore, the claims stand rejected.

5. Claims 1 – 3 and 16 – 18 stand rejected under 35 U.S.C. 102(b) as being anticipated by Dolotovskaya.

Applicant claims a burnet extract comprising about 0.25 – 20% burnet derived compounds, 0.5 – 10% burnet derived compounds or about 3% burnet derived compounds. Applicant additionally claims an external skin composition comprising the burnet extract wherein the composition is selected from a skin treatment lotion, facial freshener, moisturizing lotion, acne treatment, after shave, sunscreen, cleansing cream, skin cream, antiperspirant/deodorant and make up base. Specifically the composition is moisturizing lotion.

Dolotovskaya teaches an aftershave cream comprising 0.1 – 2.0% extracts of burnet root (abstract).

The reference anticipates the claimed subject matter.

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Since applicant does not provide arguments regarding this rejection, the claims stand rejected.

6. Claims 1 - 3 and 16 - 18 stand rejected under 35 U.S.C. 102(b) as being anticipated by Yong.

Applicant claims a burnet extract comprising about 0.25 - 20% burnet derived compounds, 0.5 - 10% burnet derived compounds or about 3% burnet derived compounds. Applicant additionally claims an external skin composition comprising the burnet extract wherein the composition is selected from a skin treatment lotion, facial freshener, moisturizing lotion, acne treatment, after shave, sunscreen, cleansing cream, skin cream, antiperspirant/deodorant and make up base. Specifically the composition is a moisturizing lotion.

Yong teaches a burn treatment composition for healing (treating) skin comprising *Sanguisorba officinalis* (burnet) (abstract) at 5 - 10 parts (col.3 line 1-6). The compositions are formulated into creams, lotions or gels and may further comprise emulsifiers, emollients (skin conditioning agents) (col.1 line 65 - col.2 line 3) and other components that promote healing of burns and other skin problems (col.2 line 34-39).

Although Yong does not specifically teach the burnet components comprising the specified amounts of burnet derived compounds, the burnet root itself inherently contains burnet derived compounds. As such, the composition of Yong must inherently contain burnet derived compounds. Therefore the reference anticipates the claimed subject matter.

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Applicant argues that Yong does not teach a non-glycolic burnet extract and does not teach the claimed function.

However, these arguments fail to persuade because as indicated above, Yong teaches compositions comprising the burnet plant. As such, the composition inherently contains burnet, thus extracts of burnet (including non-glycolic extracts).

Regarding the claimed function, the intended use or function of the claimed composition does not patentably distinguish the composition, per se, since such undisclosed use is inherent in the reference composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the composition of the prior art. In the instant case, the intended use fails to create a structural difference, thus, the intended use is not limiting.

Therefore the claims stand rejected.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

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evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1 – 3 and 16 – 19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Yong.

Applicant claims a burnet extract comprising about 0.25 – 20% burnet derived compounds, 0.5 – 10% burnet derived compounds or about 3% burnet derived compounds. Applicant additionally claims an external skin composition comprising the burnet extract wherein the composition is selected from a skin treatment lotion, facial freshener, moisturizing lotion, acne treatment, after shave, sunscreen, cleansing cream, skin cream, antiperspirant/deodorant and make up base. Specifically the composition is a moisturizing lotion comprising at least one each of an oil, skin conditioning agent, humectant, emulsifier and emulsion stabilizer.

Yong teaches a burn treatment composition for healing (treating) skin comprising *Sanguisorba officinalis* (burnet) (abstract) at 5 – 10 parts (col.3 line 1-6). The compositions are formulated into creams, lotions or gels and may further comprise emulsifiers, emollients (skin conditioning agents) (col.1 line 65 – col.2 line 3) and other components that promote healing of burns and other skin problems (col.2 line 34-39).

Yong does not specifically teach the burnet component comprises the specified amounts of burnet derived compounds. However, at the time of the claimed invention, it was known in

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the art that burnet root inherently contains burnet derived compounds. As such, the composition of Yong must inherently contain burnet derived compounds. At the time of the claimed invention, it would have been obvious to one of ordinary skill in the art to optimize the amounts of burnet in the composition of Yong since it was routine practice in the art at the time the claimed invention was made. Moreover, at the time of the claimed invention, one of ordinary skill in the art would have been motivated by routine practice to optimize the amounts of active extracts in the compositions of Yong with a reasonable expectation for successfully obtaining an effective burn treatment (or skin treating) lotion.

Yong does not teach the composition comprising an oil component, humectant and emulsion stabilizers. However, Yong does teach the composition further contains components that promote healing from burns and skin problems. Furthermore, at the time of the claimed invention, such components were well recognized in the art in skin care compositions. At the time of the claimed invention, one of ordinary skill in the art would have been motivated by Yong and routine practice to include additional skin care ingredients such as stabilizers, humectants and oils with a reasonable expectation for successfully obtaining an effective burn treatment (or skin treating) lotion.

Applicant argues that Yong does not teach a non-glycolic burnet extract and does not teach the claimed function.

However, these arguments fail to persuade because as indicated above, Yong teaches compositions comprising the burnet plant. As such, the composition inherently contains burnet, thus extracts of burnet (including non-glycolic extracts).

Regarding the claimed function, the intended use or function of the claimed composition does not patentably distinguish the composition, per se, since such undisclosed use is inherent in the reference composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the composition of the prior art. In the instant case, the intended use fails to create a structural difference, thus, the intended use is not limiting.

Therefore the claims stand rejected.

10. Claims 1 – 3 and 16 – 19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Dolotovskaya.

Applicant claims a burnet extract comprising about 0.25 – 20% burnet derived compounds. 0.5 – 10% burnet derived compounds or about 3% burnet derived compounds. Applicant additionally claims an external skin composition comprising the burnet extract wherein the composition is selected from a skin treatment lotion, facial freshener, moisturizing lotion, acne treatment, after shave, sunscreen, cleansing cream, skin cream, antiperspirant/deodorant and make up base. Specifically the composition is moisturizing lotion comprising at least one each of an oil, skin conditioning agent, humectant, emulsifier and emulsion stabilizer.

Dolotovskaya teaches an aftershave cream comprising 0.1 – 2.0% extracts of burnet root, lanolin, vegetable oils, emulsified waxes and water (abstract).

Dolotovskaya does not teach the composition comprising a humectant and emulsion stabilizers. However, at the time of the claimed invention, such components were well

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recognized in the art in skin care compositions. At the time of the claimed invention, one of ordinary skill in the art would have been motivated by routine practice to include additional skin care ingredients such as stabilizers and humectants with a reasonable expectation for successfully obtaining an effective after shave cream.

Applicant argues that Dolotovskaya does not teach a non-glycolic extract of burnet with the claimed function.

However, these arguments fail to persuade because Dolotovskaya specifically teaches a water/ethanol/glycol extract of burnet. Although the extract is extracted with a water/ethanol/glycol mix, it would have been well within the purview of one of ordinary skill in the art to use other solvents in the composition of Dolotocskaya, such as water and/or ethanol as a matter of routine practice. In support, see references of record Pelletier, Suzuki '595, Suzuki '052, and Yong.

Therefore, the claims stand rejected.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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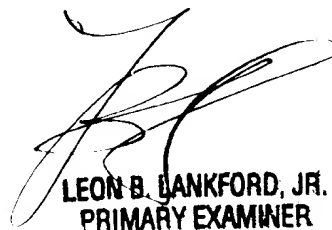
MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth A. Davis whose telephone number is 703-308-6310. The examiner can normally be reached on M-H (7:00-4:30); altn. F (7:00-3:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 703-308-0196. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Ruth A. Davis
February 27, 2003



LEON B. LANKFORD, JR.
PRIMARY EXAMINER